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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,429	09/22/2003	Makoto Kubota	03500.017562	6520

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NEW YORK, NY 10112

EXAMINER
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KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/665,429

Applicant(s)

KUBOTA ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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This action is in response to applicants' amendment of 13 January 2005. The amendments to the claims have overcome the 35 USC 112 rejections. Applicant's arguments with respect to the objection of claim 7 have been fully considered and are persuasive. The objection of claim 7 has been withdrawn. Applicant's arguments with respect to the art rejections have been fully considered but they are not persuasive.

Claims 5 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The added limitation in claim 1 of "preparing, by performing a plurality of preparation operations at different times, a sol-gel composition" and where the plurality of preparation operations comprise different preparation operations (claim 9) are new matter. Nowhere in the original disclosure is there a teaching of preparing the sol-gel composition using a plurality of preparation operations at different times or is there a teaching that the plurality of preparation operations comprises different preparation operations.

Claims 2-5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by "preparing, by performing a plurality of preparation operations at different times, a sol-gel composition". Accordingly the process of claim 5 and all the claims depending from the process are indefinite.

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The Examiner is interpreting the limitation “preparing, by performing a plurality of preparation operations at different times, a sol-gel composition” to mean that the steps of producing the sol-gel composition, including the step of producing the compositions which are used to produce the sol-gel composition and the purifying operations, occur at different times.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,203,608.

This reference teaches piezoelectric films, such as lead titanate zirconate based films, produced by forming a sol-gel composition which comprises a dispersoid obtained from organometallic compounds, applying this composition onto a substrate, drying and baking the film. The reference teaches mixing the raw organometallic compounds and purifying them. Thus the process of preparing the raw materials, the mixing operation and purification operation all occurred at different times. The reference teaches the compounds and the composition should be high purity and that it can be purified using conventional methods, such as those used by applicants (col. 4, lines 52-57). Applicants specification shows that these processes will produce composition where the total content of elemental halogen, halogen ions and halogen compounds falls within the claimed ranges. The taught film is used in piezoelectric devices, such as oscillation elements and filters which have the structure of claim 6. The reference suggests the claimed process and device.

Claims 2-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,066,581.

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This reference teaches piezoelectric films, such as lead titanate zirconate based films, produced by forming a sol-gel composition which comprises a dispersoid obtained from organometallic compounds, applying this composition onto a substrate, drying and baking the film. The reference teaches the compounds and the composition should have high purity and free of elements which are detrimental to semiconductor devices, such as chloride. It is also known that the other halogens are detrimental. Therefore the reference teaches the composition should be halogen free. The organometallic preparation operation, purification and mixing operations occurred at different times since the reference teaches to mix the purified organometallic compounds and the compounds must be prepared before they can be purified. The reference suggests the claimed process.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,203,608 as applied to claim 6 above, and further in view of U.S. patent 6,247,799.

As stated above, U.S. patent 6,203,608 suggests oscillation elements comprising a piezoelectric layer having the claimed purity. It does not teach devices in which such elements are used. U.S. patent teaches such devices are commonly used ink jet recording heads, which conventionally have the claimed structure. Therefore one of ordinary skill in the art would have found it obvious to use the oscillation element of U.S. patent 6,203,608 as the oscillation element in conventional ink jet recording heads, as described in U.S. patent 6,247,799.

Applicants argue that Sun and Chivukula do not teach the claimed added limitation of preparing the sol-gel composition by a plurality of operations at different times. As discussed above these references do teach this limitation.

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The presence of this limitation does not overcome the rejections over device claims 6-8, which are product-by-process claims. This process limitation does not distinguish the claimed devices over those taught. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

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The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk  
March 23, 2005

  
C. Melissa Koslow  
Primary Examiner  
Tech. Center 1700